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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,009	06/01/2000	Kim R. Smith	163.1269US01	4485

7590 09/18/2002

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EXAMINER

DOUYON, LORNA M

ART UNIT	PAPER NUMBER
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1751

9

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,009

Applicant(s)

SMITH ET AL.

Examiner

Lorna M. Douyon

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 8, 2002 has been entered.
2. Claims 1-34 are pending.
3. The rejection of claims 1-4, 6-22, 25-30 under 35 U.S.C. 103(a) as being unpatentable over Schulz et al. (US Patent No. 5,674,831) is withdrawn in view of applicants' amendment and arguments therein.
4. The rejection of claims 1-4, 6-22, 25-30 under 35 U.S.C. 103(a) as being unpatentable over Schulz et al. (US Patent No. 6,060,444), hereinafter "Schulz '444" is withdrawn in view of applicants' amendment and arguments therein.
5. The rejection of claims 1-34 under 35 U.S.C. 103(a) as being unpatentable over Rolando et al. (US Patent No. 5,474,698), hereinafter "Rolando" is withdrawn in view of applicants' amendment and arguments therein.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 6, 8, 9, 16-20, 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al. (JP 09217100), hereinafter "Ando".

Ando teaches a solid detergent useful for dishwashing or for hard surfaces which is manufactured by preparing a uniformly mixed detergent composition that partially contains hydrated compounds and naturally solidifying the mixture under no heating and no pressuring within the mold (see abstract; claim 3). Ando also teaches a composition containing sodium tripolyphosphate 30%, sodium metasilicate.9H₂O 20%, NaOH 35%, anhydrous sodium sulfate 11% and nonionic surfactant 4% which is prepared by filling the composition in a closed container and sitting at 20-25° for one day (see Example 20), wherein the weight ratio of the metasilicate nonahydrate to surfactant is 5:1. Ando also teaches that molding can be performed in an extruder (see [0035] of the crude translation). Ando teaches the limitations of the instant claims. Hence, Ando anticipates the claims.

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 16-26, 29-30 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scepanski (US Patent No. 5,670,473).

Scepanski teaches solid a cleaning agent which is homogeneous cast solid comprising at least 15% by weight of hydrated salt like trisodium orthophosphate dodecahydrate; between about 5 and 80% by weight anionic, nonionic surfactant or mixtures thereof; between 0 and 10% by weight of cationic emulsifiers such as isodecyloxypropyl dihydroxyethyl methyl ammonium chloride; up to about 10% by weight oxygenated solvents such as ethylene glycol monobutyl ether (which is also known as butoxy ethanol); between 0 and 20% by weight enzymes like protease, amylase, lipase and cellulase enzyme. In Examples 1-5 in Table 2, and Examples 1-3 in Table 3, Scepanski teaches cleaning compositions containing hydrated salt, surfactants and ethylene glycol monobutyl ether (see abstract; col. 8, lines 8-15; claims). Scepanski, however, fails to teach the recited process of making the detergent composition.

It should be noted that the present claims are product-by-process claims, hence any difference imparted by the product by process limitations would have been obvious to one having

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ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct, not the examiner to show the same process of making, see *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

10. Claims 5, 7, 14, 15, 21, 23, 24, 26, 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando.

Ando teaches the features as described above. In addition, Ando teaches oxygen system oxidizers such as chlorine-based oxidizers (see [0023] of the crude translation), solvents such as diethylene-glycol monobutyl ether (see [0026] of the crude translation) and well-known components such as perfume and coloring agent (see [0027] of the crude translation). Ando also teaches cleaning agent hydrates in an amount from 5-50% and the surfactant in an amount from 0.1 to 10% by weight (see Table 6). Ando, however, fails to specifically disclose the weight ratio of the hydrated component to the hydratable component (i.e., surfactant) which is between about 8:1 to about 15: 1.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best result, see *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215,

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219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

11. Claims 10-13, 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando as applied to the above claims, and further in view of Scepanski.

Ando teaches the features as described above. Ando, however, fails to teach the incorporation of enzymes like protease in his composition.

Scepanski teaches a similar composition in molded form which can include active enzymes such as protease in concentrations between 0 and 20% by weight to enhance the cleaning performance of detergents (see col. 10, lines 19-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate enzymes like protease in an effective amount to the composition of Ando because such addition would enhance the cleaning performance of detergents as taught by Scepanski.

Response to Applicants' Arguments

12. Applicants' arguments filed on July 8, 2002 have been fully considered but they are not persuasive.

With respect to the rejection based upon Scepanski, Applicants argue that in the presently claimed molded detergent composition, the solidification results from movement of the water of

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hydration from the hydrated component to the hydratable component, whereas the solidification according to Scepanski results from cooling a melt.

The Examiner respectfully disagrees with the above argument because the resulting product of the presently claimed composition is a molded detergent composition which is no different from the molded detergent composition of Scepanski. As already stated above, any difference imparted by the product-by-process limitations would have been obvious to one having ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct, not the examiner to show the same process of making, see *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324. The reference is deemed to teach the claimed composition; Applicants need to show that their invention is actually different from and unexpectedly better than the prior art, see *In re Best*, 195 USPQ 430, 433, 434 (CCPA 1977).

13. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. The reference is considered cumulative to or less material than those discussed above.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (703) 305-3773. The examiner can normally be reached on Mondays-Fridays from 8:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Technology Center is:

(703) 872-9311 - for Official After Final faxes

(703) 872-9310 - for all other Official faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-0661.

September 17, 2002

Lorna M. Douyon

Lorna M. Douyon
Primary Examiner
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